



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,189	01/25/2002	Sarah E. Campbell	D/A1496 (1508/3550)	9199

7590 11/04/2005

Gunnar G. Leinberg, Esq.
Nixon Peabody LLP
Clinton Square
P.O. Box 31051
Rochester, NY 14603-1051

EXAMINER

CARBONELLO, MICHAEL J

ART UNIT PAPER NUMBER

2622

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,189

Applicant(s)

CAMPBELL ET AL.

Examiner

Michael Carbonello

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2-12/2002, 12/20/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The Specification was received on 1/25/2002. The examiner accepts these specifications.

Drawings

2. The drawings are objected to because Figure 1, the System [10] is labeled ambiguously. The number "10" is just pointing to open space, and first impression is that is pointing to the Printing Device [12]. The examiner suggests boxing and labeling whatever portion of figure 1 is the system [10], in the same way the Printing Device [12] is labeled.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 2622

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 30 is objected to because of the following informalities: On page 16, line 20; applicant says, "set forth in claim 9." The examiner believes this is a typo and that it should read "set forth in **claim 29**," based on the pattern of the previous claims. The examiner will treat the claim as such.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 7-9,11-14,17-19, 21-24, and 27-29 are rejected under 35

U.S.C. 102(b) as being anticipated by Benjamin et al.

6. Regarding claims 1, 11 and 21, Benjamin et al discloses in column 4, lines 20-39; "requesting an identity of at least one supplier for at least one consumable for a device, identifying the at least one supplier for the at least one consumable based on the request, and displaying with the device the identified at least one supplier." Using the broadest reasonable interpretation, "As further alternatives, an internet website could be automatically accessed to enable entry of an immediate order; the computer could prompt the user for his/her zip code and then provide information regarding a nearest dealer to contact, etc." This would

Art Unit: 2622

be a method whereby the device would request the identity of a supplier, it would identify whether the supplier had the correct consumable, and display who the supplier is.

7. Regarding claim 2, 12 and 22, Benjamin et al discloses the methods and devices disclosed above, and further discloses in column 4, lines 21-22;

“indicating at the device when replacement of at least one of the consumables in the device is recommended, wherein the requesting is based on the indication.”

Using the broadest reasonable interpretation the message indicating a low ink level would indicate when replacement of a consumable is required. Further as disclosed above in line 30-39, the information request is triggered by the low ink message.

8. Regarding claim 3, 13, 23, Benjamin et al discloses the methods and devices disclosed above, and further discloses in column 4, lines 28-39;

“retrieving information about the device making the request, wherein the identifying the at least one supplier is based on the retrieved information.” Using the broadest reasonable interpretation the print out of information about replacing the ink toner and the ability to find a supplier through the Internet would be a method of identifying a least one supplier based on the retrieved information.

9. Regarding claims 4, 14, and 24, Benjamin et al discloses the methods and devices disclosed above, and further discloses in column 4, lines 35-40; “wherein the retrieved information about the device identifies a location of the device, wherein the identifying the at least one supplier is based on the identified location of the device.” Using the broadest reasonable interpretation the use of a zip code

to determine the nearest dealer would be a method that identifies a supplier based on the location of the device.

10. Regarding claims 7, 17 and 27, Benjamin et al discloses the methods and devices disclosed above, and further discloses in column 4, lines 35-40; "wherein the identifying the at least one supplier further comprises identifying a location of the identified at least one supplier, wherein the displaying the identified at least one supplier further comprises displaying the location of the identified at least one supplier." Using the broadest reasonable interpretation the ability to provide information regarding the nearest dealer to contact based on an inputted zip code would be a method to identify and display the location of at least one supplier.

11. Regarding claims 8, 18 and 28, Benjamin et al discloses the methods and devices disclosed above, and further discloses in column 4, lines 29-40; "further comprising submitting with the device an order for the at least one consumable to the at least one identified supplier." Using the broadest reasonable interpretation the output order sheet with all the necessary details to accomplish an order of a replacement ink cartridge (box 68), in addition to the described method of when using an Internet website for an immediate order would be a method of placing an order for at least one consumable to at least one identified supplier.

12. Regarding claims 9, 19 and 29, Benjamin et al discloses the methods and devices disclosed above, and further discloses in column 4, lines 29-40; "9. The method as set forth in claim 8 further comprising processing the submitted order for and supplying the at least one consumable for the device." Using the broadest

Art Unit: 2622

reasonable interpretation the ability to generate an immediate order would be viewed as method of submitting an order for the supplying the at least one consumable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5, 6, 10,15,16, 20, 25, 26 and 30 are rejected under 35 U.S.C.

103(a) as being unpatentable over Benjamin et al in view of Office Depot's archived website.

14. Regarding claim 5, 15, and 25 Benjamin et al discloses the methods and devices discussed above. Benjamin et al does not disclose, "wherein the displaying the identified at least one supplier further composes displaying the identified quantity of the at least one consumable." The Office Depot website discloses at least one supplier displaying the quantity of at east one consumable.

The result is a method whereby a supplier can identify quantity of said consumable. The motivation for combining Benjamin et al and Office Depot's website is that Benjamin et al discusses the use of automatically contacting a website in order to replace a low or empty consumable, such as an ink toner cartridge. This is merely the functioning website typical of the one described by Benjamin et al. Lastly quantity identification is a common process by which a

Art Unit: 2622

consumer notifies the seller how much of a particular product they wish to purchase or how much of a product the seller has left in stock. Therefore it would have been obvious at the time of invention for one of ordinary skill in the art to combine Benjamin et al with the Office Depot website to produce the method to identify and display the quantity of at least one consumable.

15. Regarding Claims 6, 16 and 26, Benjamin et al discloses the methods and devices discussed above. Benjamin et al does not disclose, "wherein the displaying the identified at least one supplier further composes displaying the identified price of the at least one consumable." The Office Depot Website discloses a supplier displaying the price of the at least one consumable. The result is a method whereby a supplier can identify a price for the consumable. After being triggered by low-level warning from the device. The motivation, like before for combining Benjamin et al and Office Depot's website is that Benjamin et al discusses the use of automatically contacting a website in order to replace a low or empty consumable, such as an ink toner. Lastly as shown in by Office Depot's website it is it is common practice for the supplier to display the prices of the products he wishes to sell. Therefore it would have been obvious at the time of invention for one of ordinary skill in the art to create a method that displays the price of a consumable.

16. Regarding Claims 10, 20 and 30, Benjamin et al discloses the methods and devices discussed above. Benjamin et al does not disclose; "wherein the processing the submitted order further comprises receiving a payment for the at least one consumable." The Office Depot website provides the "check out"

Art Unit: 2622

function, "shopping cart" and "apply for credit" option. Using the broadest reasonable interpretation these would be viewed as a method whereby the seller is able to receive payment for the consumable devices." The result of the combination is the ability of the user to be able to order the necessary consumable, but also more importantly it is the ability of the seller to receive payment for said consumables. The motivation is that this combination provides the seller a means to accept payment for the consumable that was order by the user. Further it is assumed that if a person is providing goods or services that a method of payment is to be expected especially when prices, virtual shopping carts, and virtual checkouts functions are clearly labeled. Thus it would have been obvious at the time of invention for one of ordinary skill in art to create a method whereby processing the order comprises receiving payment for at least one consumable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Haines et al discloses; "Methods and apparatus for generating notifications associated with the lifetime of peripheral unit consumables are described."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Carbonello whose telephone number is (571) 272-0625. The examiner can normally be reached on 8:00am - 4:30pm.

Art Unit: 2622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Carbonello
Examiner
Art Unit 2622

MJC

JOSEPH P. POKPZYWA
PRIMARY EXAMINER
ART UNIT 2622

A handwritten signature in black ink, appearing to read "Joseph P. Pokrzywa", written in a cursive style.